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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/657,494 | 09/08/2003 | Dennis M. Hilton | 621P002Div. | 1928 |
| 42754 | 7590 | 07/07/2005 | EXAMINER | |
| NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581 | | | ZEMEL, IRINA SOPJIA | |
| | | | ART UNIT | PAPER NUMBER |

1711

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,494

Applicant(s)

HILTON ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

All of the rejections not addressed below are deemed withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 11 claim amount of stabilizing agent in reference to the amount of another component, namely water, which is NOT a part of the claimed mixture. In fact, the water is *excluded* from the claimed *dry* mixture. The actual amount of water is NOT defined in any of the claims, or for that matter, anywhere in the specification with regard to the claimed dry components. The limitation of claims 10 and 11 defining the amount of stabilizing agent in reference of undefined amount of water, thus, is indefinite.

Claim 9 recites the limitation "said powder" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. While "powdered polyvinyl alcohol" is claimed in claim 2, the term "powder" does not appear in the claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of four Ayambem et al., references cited in the previous office action.

The rejection of claims stands as per reasons of record. Limitations of newly added claims 10 and 11 are inherently met by the Ayambem references since, as discussed above, the limitations recited in these claims are indefinite and would be met by ANY composition having any amount of stabilizer given that virtually any amount of water can be added to the composition to provide the composition with the property of pumpable slurry.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem in combination with applicants own admission on the record.

The Ayambem references while teaching that polyvinyl alcohols (PVA) are suitable component of the disclosed compositions, do not specifically disclose size of the of the suitable PVA powderes, thus implying that any commercially available PVA are suitable for the invention absent showing of unexpected results that can be clearly attributed to the claimed powder size. Applicants admit on the record that the claimed powder size PVA are readily available on the market, and, furthermore state that "Those skilled in the art can readily determine which commercially available polyvinyl alcohol powders in addition to the foregoing are suitable", (see top of page 7 of the instant disclosure), thus clearly implying that the claimed PVA powders are well known and choosing it would have been obvious for an ordinary artisan with reasonable expectation of adequate results.

Response to Arguments

Applicant's arguments filed 3-29-2005 have been fully considered but they are not persuasive. Applicants first argument is that the compositions disclosed by the

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Ayambem references necessarily contains water, while the instant invention claims dry compositions. However, the references clearly state that the dry component may be pre-blended. See column 7, lines 45-52 of '185 reference. (future references to specific columns and lines are all made with regard to the '185 patent). Furthermore, in the illustrative examples the drying-type joint compound (which includes, for example, gypsum as per disclosure in column 8, lines 21-26) is first dry blended with a water soluble polymeric set retarder. Addition of binders (dry components as per column 7, lines 45-52, is also within purview of the references. Therefore, dry compositions containing all the claimed elements (even though, they are disclosed as intermediate compositions) are clearly within the purview of the reference.)

The applicants argue that the Ayambem references differ from the claimed invention in the amounts of stabilizing agent. This argument is not persuasive for several reasons. First of all, as discussed above, the amount of the stabilizing agent is defined in respect of unidentified amount of water that will be added to the claimed dry composition and not with respect to the other required dry components. Thus, the amounts of stabilizing agent is NOT clearly defined in either the claims or the specification. Second, the functional language added to the base claims 1 "said foam stabilizing agent being present in said dry mixture in an amount effective for stabilizing said settable foam" is a relative language and any amount of stabilizing agent would provide some degree of stabilization. Moreover, in regard of claims not specifically claiming PVA as the stabilizing agent, the reference expressly disclosed addition of what it calls "thickeners", such as, for example, hydroxyethyl cellulose, which, by itself,

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metts the limitation of stabilizer, since such compounds are disclosed as suitable (although not preferred) stabilizing compounds on page 7 of the instant specification. The amounts of "thickeners" is disclosed as up to 5 %. See column 8, lines 44-60 of the Ayambem reference.

Lastly, the applicants argue that the Ayambem references do not disclose specific properties of the mixture upon application of mechanical turbulence. While the reference does not disclose such property, as stated in the previous office action, it is reasonable believed that the claimed property would have been inherently met by the compositions disclosed by Ayambem which contain substantially the same components in substantially the same amounts. Instead of arguing that the reference does not disclose a given inherent property of the composition, the applicants burden, as discussed in the previous office action, is to provide factual evidence that the disclose compositions do NOT, in fact, exhibit the claimed properties. No evidence is provided by the applicant to that effect.

Therefore, the invention as claimed, is still considered to have been obvious over the disclosure of the Ayambem references.

Applicants should note that a provisional double patenting rejection over claims of co-pending application 10/674,745 will likely to be issued should any of f the claims of either this of the referenced co-pending application be found allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ



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